

REMARKS

Claims 1-17 are now pending in the application. Claims 1, 6, and 7 are now amended. The claim amendments are fully supported by the application as filed and do not introduce new subject matter. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 112

Claims 1-17 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. The Examiner found the word "such" to be unclear in claims 1 and 7. The Applicants respond by amending the claims to remove the term; and it is therefore believed that this rejection is overcome. Important to note is that this is not a substantive amendment to the claims and is merely intended to clarify the Applicants' original intent.

REJECTION UNDER 35 U.S.C. § 102

Claims 1-8 and 10-17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Abdel-Malek et al. (U.S. Pat. No. 6,959,235) (hereinafter referred to as "Abdel-Malek"). This rejection is respectfully traversed.

The Applicants believe claims 1 and 7 to be allowable because the claims and the prior art differ. For anticipation to be present under 35 U.S.C. § 102(b), there must be no difference between the claimed invention and the reference disclosure as viewed by one skilled in the field of the invention. Scripps Clinic & Res. Found. V. Genentech,

Inc., 18 USPQ.2d 1001 (Fed. Cir. 1991). All of the limitations of the claim must be inherent or expressly disclosed and must be arranged as in the claim. Constant v. Advanced Micro-Devices, Inc., 7 USPQ.2d 1057 (Fed. Cir. 1988).

Regarding claims 1 and 7, the Applicants have carefully reviewed Abdel-Malek, especially Fig. 1, Column 9, Lines 39-67, and Column 10, Lines 1-40 and find no teaching that *whenever* a request to order a part is entered or an inquiry made, a hint will is displayed.

Abdel-Malek is concerned with providing a technician with quick and easy access to detailed repair information. Abdel-Malek does not disclose or suggest the system as claimed including the automatic display of a hint when a part is ordered. Instead, Abdel-Malek merely includes providing access to database information, which is common in the prior art. Because the prior art fails to teach each and every limitation of claims 1 and 7, namely an automatic display of a hint whenever a request or inquiry is made for a part, claims 1 and 7 are believed to be allowable. Claims 2-6 and 8-11 depend from claims 1 and 7 and are believed to be allowable for at least this reason.

Regarding claim 10, the Office Action alleges that Abdel-Malek inherently discloses a displayed hint alerting a viewer that a problem will not be solved by replacement of a component. However, the Applicants find no support for this assertion. Abdel-Malek includes a typical system that provides research tools for a technician. Abdel-Malek does not teach or suggest a visual alert indicating that replacing a part will *not* solve a particular problem as claimed. Such a visual alert saves time and resources by eliminating need of research into determining whether a part replacement will in fact solve the problem. As Abdel-Malek is not directed to such

research avoidance visual alerts, it is unclear as to how this visual alert can be inherently disclosed. Because claim 10 includes an element not contemplated by the prior art, claim 10 is believed to be new and non-obvious. For at least this reason and the reasons set forth above, claim 10 is believed to be allowable.

Regarding claim 15, the Applicants have thoroughly reviewed Column 10, Lines 13-15 and find that Abdel-Malek fails to teach or suggest preventing completion of an order for a part until receipt of a signal acknowledging a display of the hint as claimed. Instead, Column 10, Lines 13-15 state that: "[r]epair parts ordered for a specific repair are matched with the locomotive configuration to ensure the correct part is obtained." Merely matching of parts is not equivalent to preventing completion of an order until a signal is received acknowledging a display of a hint. The claimed signal requirement acts as a failsafe for situations where the hint indicates that the part should not be replaced. Because the limitations of claim 15 are not disclosed or suggested by the prior art, claim 15 is believed to be allowable for at least this additional reason.

REJECTION UNDER 35 U.S.C. § 103

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Abdel-Malek et al. (U.S. Pat. No. 6,959,235) in view of Demetriades et al. (U.S. Pat. No. 2004/0010578) (hereinafter referred to as (Demetriades"). This rejection is respectfully traversed.

Applicant respectfully asserts that the Examiner has failed to clearly and particularly support his alleged motivation to combine these references using actual evidence as required. According to established mandates of the patent laws, "[t]o

establish a prima facie case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. § 2142. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." M.P.E.P. § 2143.01.

"The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). The showing must be "clear and particular, and it must be supported by actual evidence." *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 1334, 63 U.S.P.Q.2d 1374, 1387 (Fed. Cir. 2002) (quoting *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999)) (emphasis added). It is not sufficient to rely on "common sense and common knowledge," as there must be specific evidence to support the motivation. *In re Lee*, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002)]. It is respectfully submitted that the Patent Office has not made a legally sufficient showing of a motivation to combine based on actual, specific, evidence.

Rather, according to M.P.E.P. § 2142, "[t]o reach a proper determination under 35 U.S.C. 103, . . . impermissible hindsight must be avoided and the legal conclusion [of obviousness] must be reached on the basis of the facts gleaned from the prior art." Furthermore, according to M.P.E.P. § 2143.01, "[t]he mere fact that references can be . . . modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of [such modification]." *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Abdel-Malek is directed to a typical diagnosis and repair system and Demetriades, on the other hand, is directed to a typical computer network system for integration of routes in a transport system. The Office Action alleges that Paragraph 0161 of Demetriades suggest the proposed combination; however, upon careful analysis, the Applicants find no support for this assertion. Paragraph 0161 makes no mention that a hint (or any problem diagnosis tool, as in Abdel-Malek) could or should be periodically transmitted to the translation service of Demetriades and merely describes format translators for output over a proprietary network of a transport system. In other words, Paragraph 0161 does not teach or suggest applicability of such format translators to a diagnosis and repair system. Even if all the elements of a claimed invention are in the prior art, which they are not, obviousness may only be found through a teaching or suggestion in support of the combination.

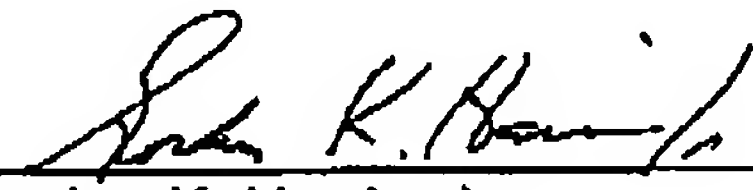
Since the Patent Office has offered no proper support or motivation for combining the references, it is respectfully submitted that the rejection based on obviousness is clearly and unequivocally founded upon "knowledge gleaned only from applicant's disclosure." M.P.E.P. § 2145. Consequently, it is respectfully submitted that the rejection entails hindsight and is, therefore, improper. Claim 9 is therefore believed to be allowable for at least this reason.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested

Respectfully submitted,

Dated: September 19, 2006

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